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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,280	07/30/2001	Takashi Matsumoto	FUJY 18.878	2410

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EXAMINER

REILLY, SEAN M

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,280

Applicant(s)

MATSUMOTO, TAKASHI

Examiner

Sean Reilly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This case has been assigned to a new Examiner. This Office action is in response to Applicant's amendment and request for reconsideration filed on 3/21/05. Claims 1-22 are presented for further examination. Independent claims 1, 2, and 14 have been amended.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyllander et al, (WO 99/12365; hereinafter Hyllander) and Mullender (Distributed Systems Second Edition).
2. As per claims 1, 2, 5, 7, 8, 13, 15, 16, 18, and 19 Hyllander teaches a speech communication service providing system comprising: a server (11, fig. 2) connected to the Internet (3, fig. 2; and a call control (11, fig. 2; a call control unit (CU) is a component of Telephony/Internet server (TIS)) unit of speech communications, said server including: (A) a module of generating, when receiving a piece of first address information (page 13, line 26; internet address of recipient Internet telephony user is designated as first address information) as a piece of address information of a destination of a speech communication from a terminal device (page 13, line 31 - page 14, line 1), a piece of information corresponding to the first address information (page 7,

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line 10; server correlates and stores call information and address information for future reference); (B) a module of storing the call status information and the first address information (page 7, line 10; server correlates and stores call information and address information for future reference); (C) a module of notifying said terminal device (8, fig. 2) of the call status information and second address information as a piece of address information of said control unit (page 14, lines 1-3; server notifies originating caller of calling status and server's telephone number [server's telephone number is equivalent to second address information for the caller to call back for connecting service), and (D) a module of notifying and correlating the call with the call status information and first address information previously stored in memory from said control unit between the caller and recipient before connecting the call (page 14, lines 8-16), said control unit (as a component of the server) including: (a) a module of inquiring of, when receives a call including a call status information from said terminal device (8, fig. 2), said terminal device transmitting the call using the second address information received from said server (page 14, lines 5-6., mobile device, using the second address information (server's phone number), calls the server in order to connect with the server), said server about the first address information corresponding to the call status information included in the call (page 14, lines 8-16; server correlates the call with the call status information and first address information previously stored in memory before connecting the call as stated above; and (b) a module of performing, when receiving the corresponding first address from said server, processes in order that the call from said terminal device arrives at another terminal device corresponding to the first address information (page 14, lines 13-16; after the server verifies the call status and first address

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information previously stored in memory with the call data, server connects the call between the caller and recipient).

Hyllander failed to *specifically recite* generating *call identifying information* corresponding to the call of the first address. Nevertheless, Hyllander did disclose associating the first address (Internet address, e.g. destination address) of a call with the telephone number (A-telephone number) of the mobile subscriber placing call (pg 7, lines 10-14), thereby allowing the system to identify the telephone call within system through the mobile subscriber's telephone number. Thus, the mobile subscriber's telephone number is used to identify a call within the system.

Hyllander also fails to specifically recite that the call is *assumed to be incorrect* when first address information does not exist. However, within Hyllander's system, when said control unit can not receive the first address information corresponding to the call identifying information (associated Internet address with A-telephone number pg 7, lines 10-14) from the server, *said control unit does not respond to the call since, it would be impossible for the system to do so without the first address information*. Further, it was well known in the art to assume missing data is *incorrect* while completing a transaction (such as completing a telephone call in the instant case), as evidenced by Mullender. In an analogous art, Mullender disclosed missing data elements are incorrect and should be identified accordingly within a system (Mullender pg 420 Failures and Faults). Thus, I would have been obvious to having ordinary skill in the art to deem a call as incorrect when first address information is missing, so errors can be detected by the system (Mullender pg 420 Failures and Faults).

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3. As per claims 3, 4, and 6, it is well known in the art for the mobile terminal device (8, fig. 2) to send its positional location to server (11, fig. 2) connected to the Internet (3, fig. 2) when requesting services from the server. Hence, it would have been obvious to one of ordinary skill in the art to allow the mobile device to inform the server of its geographical location for billing purposes and other customized products that correspond to that location such as location-specific advertisements and/or weather emergencies.

4. Claims 9 and 20 are rejected for similar reasons as claim 1. Hyllander teaches the server (11, fig. 2) sends the call status and second address information (server's telephone number) to the terminal device (8, fig. 2) for connection purposes (page 14, lines 1-3). Hyllander does not disclose said server sends the call identifying information and the second address information in format that is visually unrecognizable by the user, and said control unit receives the call transmitted based on an instruction inputted in a state where the user of said terminal device does not know the call identifying information and the second address information. It is well known in the art to protect the identity of the message (call ID number, phone numbers, other private data, etc.) by encrypting its contents in format that is not visually recognizable by the user. Hence, it would have been obvious to one of ordinary skill in the art to use encryption technologies to encrypt the data by concealing its contents and protecting private data from unauthorized access. Only devices that have the encryption keys can decode the encrypted message.

5. Claims 10, 17 and 21 are rejected for similar reasons as claims 3, 4, and 6.

6. As per claims 11 and 22, Hyllander teaches the server transmits a request for user authentication information to said terminal device and, only when the user authentication information received from said terminal device is valid, notifies said terminal device of the call

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identifying information and the second address information (page 13, lines 28-29; system verifies and certifies caller's identification data before authenticating the user for service).

7. As per claims 12 and 13, Hyllander teaches the mobile terminal device, (8, fig. 2) using second address information (server's telephone number), dials and connects to the an access point (11, fig. 2; telephony/internet server) for Internet telephony service (page 14, lines 5-6).

Hyllander does not disclose the system providing the second address information of the control unit closest to terminal device. It is well known in the art for the terminal device to call and connect with an access point that is closest to its present location for service. Hence, it would have been obvious to one of ordinary skill in the art to be motivated to allow the terminal device to connect with an access point closest to its location in order to reduce connection costs and minimize service interruptions comparable to when the mobile device has to connect to an access point that is far away.

8. Claim 14 is rejected for similar reasons as claim 1. Hyllander further teaches first (4, fig. 1; telephony/internet server is functionally equivalent to an access point that connects the terminal device to the Internet) and second (5, fig. 1) access points to the Internet (3, fig. 1) telephony network.

Response to Arguments

9. In response to Applicant's request for reconsideration filed on 3/21/05, the following factual arguments are noted:

- a. Hyllander failed to disclose the prevention of invalid access to the control unit.

In considering (a), the Examiner respectfully disagrees with Applicant's argument. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the prevention of invalid access to the control unit) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Further, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Based on the arguments presented by Applicant it is presumed that the Applicant believes the newly amended limitations, *prevent invalid access to the control unit*. Applicant is invited to review the above office action to see how the specific claim language has been mapped. It is further brought to Applicant's attention that Hyllander's system associates a call with the mobile subscribers telephone number (pg 7, lines 10-14), which is later used to retrieve the number to be dialed (pg 14 lines 10-16). This call connection scheme (i.e. storing a call record for later retrieval and later using the record to complete the call) is synonymous with Applicant's claimed invention. Also synonymous with Applicant's invention, within Hyllander's system if the destination number is unable to be obtained (during the process on pg 14, lines 10-16) than the call connection is not be completed.

Conclusion

10. The prior art made of record, in PTO-892 form, and not relied upon is considered pertinent to applicant's disclosure.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Reilly whose telephone number is 571-272-4228. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


6/20/05


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